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09/801,291	03/07/2001	Matthew S. Chang	450103-02815	3787

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NEW YORK, NY 10151

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/801,291

**Applicant(s)**

CHANG ET AL.

**Examiner**

Nicholas D. Rosen

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-29 have been examined.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "26" has been used to designate both the display on a television set (in Figures 1 and 3) and "other audio/visual devices" (in Figure 1). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it substantially exceeds the permitted length. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: "26" is used to refer to both the display on a TV set (page 5, line 15; page 12, line 18; page 13, line 11; and page 15, line 13) and "other audio/visual devices" (page 5, line 16).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37.CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### **Claims 1-7**

Claims 1, 2, 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (U.S. Patent 5,870,155) in view of Nemirofsky (5,880,769). As per claim 1, Erlin discloses a system for enabling a user to purchase an item displayed

on a display screen of a television receiver, said system comprising: means adapted to be coupled to a television receiver for receiving television signals (Figures 1 and 4; column 4, lines 20-28), and discloses application to a cable TV home shopping network (Abstract), meaning that the television signals can be representative of a number of items offered for sale. Erlin does not quite expressly disclose providing the received television signals to said television receiver so as to enable the item or items offered for sale to be displayed on the display screen, although this could be considered inherent from "home shopping network," but in any event, Nemirofsky teaches that a home shopping network involves enabling items offered for sale to be displayed on a television display screen (column 5, lines 60-66; column 6, lines 20-27). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to provide the received television signals to said television receiver to enable the item or items offered for sale to be displayed on the display screen, for the obvious advantage of letting customers see what is available, and making them more likely to make purchases.

Erlin discloses reading means for reading information from a card and for forwarding the read information to the receiving and providing means (Figures 1, 2, 6A, 6B, 6C, 6D, 6E, 6F, 6G, and 6H; column 4, line 57, through column 5, line 42).

As per claim 2, Erlin discloses that the receiving and providing means includes mean for processing the read information in a predetermined manner and for outputting the same for supply to an external destination so as to enable payment for a desired

item (Figures 3, 4, 6A, 6B, 6C, 6D, 6E, 6F, 6G, and 6H; column 4, line 57, through column 5, line 42).

As per claim 3, Erlin discloses that said card includes a magnetic storage area having information stored therein, and that said reading means reads the stored information from said magnetic storage area (column 3, lines 3-7; column 3, line 61, through column 4, line 4).

As per claim 5, Erlin discloses disclose that the receiving and providing means includes a set-top box (column 2, lines 50-67; column 4, lines 20-28).

As per claim 7, Erlin discloses that the reading means includes transmitting means for transmitting the read information in a wireless manner to the receiving and providing means (Figures 3, 4, and 5; column 2, lines 50-67; column 4, line 57, through column 5, line 42).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 2 above, and further in view of Borowsky ("A Long and Winding Road") and official notice. Erlin does not disclose that said card includes an integrated circuit (IC) chip having information stored therein, and that said reading means reads the stored information from said IC chip, but Borowsky teaches the use of smart cards or chip cards, using the terms interchangeably (entire article), and in particular teaches a smart card and smart card reader for enabling consumers to order products via TV and pay for them with a smart card and smart card reader at home (second last paragraph, beginning, "What's more, the expansion of home banking"). Official notice is taken that chip cards have IC chips. Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the card include an integrated circuit (IC) chip having information stored therein, and have said reading means read the stored information from said IC chip, for the stated advantages of cutting fraud losses and storing more information than can feasibly be stored on a magnetic strip.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 2 above, and further in view of official notice. Erlin does not disclose that the reading means is coupled to the receiving and providing means by way of a data line, unless IR transmission counts as a data line. However, official notice is taken that data lines are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the reading means coupled to the receiving and providing means by way of a data line, and to have the reading means forward the read information to the receiving and providing means by way of said data line, for the obvious advantage of conveniently and reliably transmitting the read information, without even requiring the user to point a remote control unit at a TV set.

#### **Claims 8-14**

Claims 8, 9, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (U.S. Patent 5,870,155) in view of Nemirofsky (5,880,769). As per claim 8, Erlin discloses a system for enabling a user to purchase an item displayed on a display screen of a television receiver, said system comprising: a commerce device coupled to a television receiver for receiving television signals (Figures 1 and 4;

column 4, lines 20-28), and discloses application to a cable TV home shopping network (Abstract), meaning that the television signals can be representative of a number of items offered for sale. Erlin does not quite expressly disclose providing the received television signals to said television receiver so as to enable the item or items offered for sale to be displayed on the display screen, although this could be considered inherent from "home shopping network," but in any event, Nemirofsky teaches that a home shopping network involves enabling items offered for sale to be displayed on a television display screen (column 5, lines 60-66; column 6, lines 20-27). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to provide the received television signals to said television receiver to enable the item or items offered for sale to be displayed on the display screen, for the obvious advantage of letting customers see what is available, and making them more likely to make purchases.

Erlin discloses a card reader for reading information from a card and for forwarding the read information to the commerce device (Figures 1, 2, 6A, 6B, 6C, 6D, 6E, 6F, 6G, and 6H; column 4, line 57, through column 5, line 42).

As per claim 9, Erlin discloses that the receiving and providing means includes mean for processing the read information in a predetermined manner and for outputting the same for supply to an external destination so as to enable payment for a desired item (Figures 3, 4, 6A, 6B, 6C, 6D, 6E, 6F, 6G, and 6H; column 4, line 57, through column 5, line 42).



As per claim 10, Erlin discloses that said card includes a magnetic storage area having information stored therein, and that said card reader reads the stored information from said magnetic storage area (column 3, lines 3-7; column 3, line 61, through column 4, line 4).

As per claim 12, Erlin discloses disclose that the commerce device includes a set-top box (column 2, lines 50-67; column 4, lines 20-28).

As per claim 14, Erlin discloses that the card reader includes a transmitter which transmits the read information in a wireless manner to the commerce device (Figures 3, 4, and 5; column 2, lines 50-67; column 4, line 57, through column 5, line 42).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 9 above, and further in view of Borowsky ("A Long and Winding Road") and official notice. Erlin does not disclose that said card includes an integrated circuit (IC) chip having information stored therein, and that said card reader reads the stored information from said IC chip, but Borowsky teaches the use of smart cards or chip cards, using the terms interchangeably (entire article), and in particular teaches a smart card and smart card reader for enabling consumers to order products via TV and pay for them with a smart card and smart card reader at home (second last paragraph, beginning, "What's more, the expansion of home banking"). Official notice is taken that chip cards have IC chips. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the card include an integrated circuit (IC) chip having information stored therein, and have said card reader read the stored information from said IC chip, for the stated

advantages of cutting fraud losses and storing more information than can feasibly be stored on a magnetic strip.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 9 above, and further in view of official notice. Erlin does not disclose that the card reader is coupled to the commerce device by way of a data line, unless IR transmission counts as a data line. However, official notice is taken that data lines are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the card reader coupled to the commerce device by way of a data line, and to have the card reader forward the read information to the commerce device by way of said data line, for the obvious advantage of conveniently and reliably transmitting the read information, without even requiring the user to point a remote control unit at a TV set.

#### **Claims 15-18**

Claims 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (U.S. Patent 5,870,155) in view of Nemirofsky (5,880,769) and Matthews, III et al. (U.S. Patent 6,025,837). As per claim 15, Erlin discloses a system for enabling a user to purchase an item displayed on a display screen of a television receiver, said system comprising: a set-top box comprising a processor and adapted to receive television signals and provide the received television signals to said television receiver (Figures 3 and 4; column 2, lines 50-67; column 4, lines 20-28) and discloses application to a cable TV home shopping network (Abstract), meaning that the television signals can be representative of a number of items offered for sale. Erlin does not quite

expressly disclose providing the received television signals to said television receiver so as to enable the item or items offered for sale to be displayed on the display screen, although this could be considered inherent from "home shopping network," but in any event, Nemirofsky teaches that a home shopping network involves enabling items offered for sale to be displayed on a television display screen (column 5, lines 60-66; column 6, lines 20-27). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to provide the received television signals to said television receiver to enable the item or items offered for sale to be displayed on the display screen, for the obvious advantage of letting customers see what is available, and making them more likely to make purchases.

Erlin further discloses a credit card reader adapted to read information from a credit card when said credit card is provided thereto by said user, and forward the read information to the set-top box, wherein said set-top box processes the information received from said credit card reader in a predetermined manner, and outputs the same for supply to an external destination so as to enable payment for a desired item (Figures 1, 2, 6A, 6B, 6C, 6D, 6E, 6F, 6G, and 6H; column 4, line 57, through column 5, line 42). Erlin does not expressly disclose, in those exact terms, that the set-top box has a back-channel and outputs information received from the credit card reader by way of the back-channel, but Matthews teaches that any of various means for sending information back from a cable TV to the headend can be called a back-channel (column 6, lines 22-32). Since information is sent back to the cable TV home shopping network (or other

environment) in Erlin's invention, the means for sending the information is therefore a back-channel.

As per claim 16, Erlin discloses that said credit card includes a magnetic storage area having information stored therein, and that said credit card reader reads the stored information from said magnetic storage area (Abstract; column 3, lines 3-7; column 3, line 61, through column 4, line 4).

As per claim 18, Erlin discloses that the external destination is one of a store, a credit card company, and a manufacturer (Abstract; a home shopping network qualifying as a type of store).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin, Nemirofsky, and Matthews as applied to claim 2 above, and further in view of Borowsky ("A Long and Winding Road") and official notice. Erlin does not disclose that said credit card includes an integrated circuit (IC) chip having information stored therein, and that said credit card reader reads the stored information from said IC chip, but Borowsky teaches the use of smart cards or chip cards, using the terms interchangeably (entire article), and in particular teaches a smart card and smart card reader for enabling consumers to order products via TV and pay for them with a smart card and smart card reader at home (second last paragraph, beginning, "What's more, the expansion of home banking"). Official notice is taken that chip cards have IC chips. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the credit card include an integrated circuit (IC) chip having information stored therein, and have said credit card reader read the stored

information from said IC chip, for the stated advantages of cutting fraud losses and storing more information than can feasibly be stored on a magnetic strip.

**Claims 19-25**

Claims 19, 20, 21, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (U.S. Patent 5,870,155) in view of Nemirofsky (U.S. Patent 5,880,769). Claims 19, 20, 21, 23, and 25 are essentially parallel to claims 1, 2, 3, 5, and 7, respectively, and rejected on closely similar grounds.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 20, and further in view of Borowsky and official notice. Claim 22 is closely parallel to claim 4, and rejected on closely similar grounds.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin and Nemirofsky as applied to claim 20, and further in view of official notice. Claim 24 is closely parallel to claim 6, and rejected on closely similar grounds.

**Claims 26-29**

Claims 26, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (U.S. Patent 5,870,155) in view of Nemirofsky (U.S. Patent 5,880,769) and Matthews (U.S. Patent 6,025,837). Claims 26, 27, and 29 are essentially parallel to claims 15, 16, and 18, respectively, and rejected on closely similar grounds.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin, Nemirofsky, and Matthews as applied to claim 26, and further in view of Borowsky and

official notice. Claim 28 is closely parallel to claim 17, and rejected on closely similar grounds.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Diehl et al. (U.S. Patent 5,173,589) disclose a process for instantaneous confirmation of actions in relation to television programs and a device for use of the process. Henderson et al. (U.S. Patent 5,603,078) disclose a remote control device with credit card reading and transmission capabilities having multiple IR LED's. Erlin (U.S. Patent 6,275,991) discloses an IR transmitter with an integral magnetic stripe ATM type credit card reader. Krishnan et al. (U.S. Patent Application Publication 2002/0087968) disclose a set-top box with a credit card reader (related to instant application). Pugh et al. (U.S. Patent Application Publication 2002/0166126) disclose an interactive intelligent video entertainment system.

Davis et al. (WO 98/49658) disclose an Internet payment and loading system using a smart card.

The anonymous article, "It's Later than You Think," discloses paying for airline tickets by swiping a credit card through a card reader attached to a television. Baron ("IBM, Europay Plan system on the Net") discloses a card reader attached to a television. The English abstract of the article "L'Internet au Walawa," discloses a smart card reader for allowing users to identify themselves when they play on-line, or pay for their on-line purchases.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

April 9, 2004